

**REMARKS**

Applicant hereby traverses the outstanding objection and rejections and requests reconsideration and withdrawal in light of the remarks contained herein. Claims 3-4 and 14-15 are indicated as having allowable subject matter. Claims 1-20 are pending in this application.

**Objection to the Drawings**

The Office Action has objected to the drawings, specifically that the Figures must show the formulas for the PID factors.

Applicant respectfully notes that Figure 3 depicts PID controller(s) 24 which is a structural element that uses the PID factors. Thus, Applicant believes that depiction satisfies the requirements of the Office Action. Moreover, Applicant notes that 35 U.S.C. § 113 provides that the applicant shall furnish a drawing where necessary for the understanding of the subject matter to be patented. In the instant case, the PID factors can be understood from the text of the specification and a drawing that merely shows the PID factors does not provide any better understanding of the PID factors than the understanding ascertained from the specification.

Accordingly, the Applicant requests that the Examiner reconsider and withdraw the drawing objection.

**Rejection under 35 U.S.C. § 112**

Claims 1-20 stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite. Specifically, the words “the one application” and “allocation request value” in claims 1, 12, and 18 asserted by the Office Action as being unclear; the term “the goal”, as used in claims 1, 12, and 18 lacks antecedent basis; and in claims 1, 12, and 18, the term “calculator” and the term “arbiter” lack structural relationships. The remaining claims appear to be rejected as being dependent from a rejected base claim.

Applicants have amended claims 1, 9, 12, 16, and 18-19 to clarify that the one application refers to the at least one application. The claims have been amended only for the purpose of complying with the requirements of 35 U.S.C. § 112, second paragraph, and not

for the purpose of narrowing their scope in the face of prior art. No new matter has been entered.

Applicants respectfully request the reconsideration of the indefiniteness of the words “allocation request value”. Applicants believe that the use of the words in the claim is clear and definite. For example, in claim 1 the allocation request value is determined by the calculator and is used by the arbiter. Thus, Applicants believe that the words “allocation request value” are clear and definite.

Applicants have amended claims 1-3, 5, 7, 9, 12-14, 16, and 18-19 to clarify that the goal refers to the at least user-defined goal. The claims have been amended only for the purpose of complying with the requirements of 35 U.S.C. § 112, second paragraph, and not for the purpose of narrowing their scope in the face of prior art. No new matter has been entered.

Applicants respectfully request the reconsideration of the indefiniteness of the words “calculator” and “arbiter”. Applicants believe that the use of the words in the claim is clear and definite, and that the claims have the essential cooperative relationships between these words. For example, in claim 1 the calculator and the arbiter are cooperatively connected through the allocation request value, where the allocation request value is determined by the calculator and is used by the arbiter. Thus, Applicants believe that these words are clear and definite.

As each element of indefiniteness cited by the Office Action has been addressed with a corresponding amendment or argument, Applicants respectfully request the rejection of claims 1-20 under 35 U.S.C. § 112, second paragraph be withdrawn.

### **Rejection under 35 U.S.C. § 103**

Claims 1-2, 5-13, and 16-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Eilert et al. (‘739, hereinafter Eilert) in view of Przybylski (‘873).

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to

combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Without conceding the second criteria, Applicants assert that the rejection does not satisfy the first and third criteria.

The Office Action admits that Eilert does not teach having PID factors. The Office Action attempts to cure this deficiency by introducing Przybylski, which the Office Action alleges to teach having such elements. The motivation for making the combination was presented as follows:

“It would have obvious ... to include the PID factors to the existing system and method as a way to measure/calculate functional relationships that would allow for the monitoring and/or control of various processes and resources of the facility.”

It is well settled that the fact that references can be combined or modified is not sufficient to establish a prima facie case of obviousness, M.P.E.P. § 2143.01. Eilert already has a way to measure functional relationships that would allow for the monitoring of various processes and resources of the facility, see the abstract of Eilert. Thus, the teaching of Przybylski is not needed in view of the recited motivation. Consequently, such language is merely a statement that the reference can be modified, and does not state any desirability for making the modification. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In *re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990), as cited in M.P.E.P. § 2143.01. Thus, the motivation provided by the Examiner is improper, as the motivation must establish the desirability for making the modification.

No valid suggestion has been made as to why a combination of Eilert and Przybylski is desirable. Therefore, the rejection of claims 1-2, 5-13, and 16-20 should be withdrawn.

The Office Action admits that Eilert does not teach having PID factors. The Office Action attempts to cure this deficiency by introducing Przybylski, which the Office Action alleges to teach having such elements. However, this combination, as presented, does not teach or suggest all limitations of the claimed invention.

Claim 1 defines a calculator that determines an allocation request value ... wherein the factors are calculated from the at least one user-defined goal and the performance information; and an arbiter that is operative to adjust the allocation request value into an adjusted allocation value when the allocation request value and allocation request values associated with other applications exceeds a predetermined value. Eilert does not disclose at least these limitations. The Office Action points to items 105, 115, 151, and 152 of Figure 1, all of Figure 2, and column 4, lines 6-25 of the text of Eilert. Applicants have reviewed these citations and cannot locate any corollaries to the claimed limitations, namely a calculator that determines an allocation request value, and an arbiter that adjusts the allocation request value into an adjusted allocation value when the allocation request value and allocation request values associated with other applications exceeds a predetermined value. Thus, the combination of Eilert and Przybylski does not teach all of the claimed limitations. Therefore, the Applicants respectfully assert that for the above reasons claim 1 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Claim 12 defines a computer program product that includes code for determining an allocation request value ... wherein the factors are calculated from the at least one user-defined goal and the performance information; and code for adjusting the allocation request value, and is operative when the allocation request value and allocation request values associated with other applications exceeds a predetermined value. Eilert does not disclose at least these limitations. The Office Action points to items 105, 115, 151, and 152 of Figure 1, all of Figure 2, and column 4, lines 6-25 of the text of Eilert. Applicants have reviewed these citations and cannot locate any corollaries to the claimed limitations, namely code that determines an allocation request value, and code that adjusts the allocation request value when the allocation request value and allocation request values associated with other applications exceeds a predetermined value. Thus, the combination of Eilert and Przybylski does not teach all of the claimed limitations. Therefore, the Applicants respectfully assert that for the above reasons claim 12 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Claim 18 defines a method that includes determining an allocation request value ... wherein the factors are calculated from the at least one user-defined goal and the performance information; and adjusting the allocation request value, when the allocation request value and

allocation request values associated with other applications exceeds a predetermined value. Eilert does not disclose at least these limitations. The Office Action points to items 105, 115, 151, and 152 of Figure 1, all of Figure 2, and column 4, lines 6-25 of the text of Eilert. Applicants have reviewed these citations and cannot locate any corollaries to the claimed limitations, namely determining an allocation request value, and adjusting the allocation request value when the allocation request value and allocation request values associated with other applications exceeds a predetermined value. Thus, the combination of Eilert and Przybylski does not teach all of the claimed limitations. Therefore, the Applicants respectfully assert that for the above reasons claim 18 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Claims 2, 5-11, 13, 16-17, and 19-20 depend from base claims 1, 12, and 18, respectively, and thus inherit all limitations of their respective base claims. Each of claims 2, 5-11, 13, 16-17, and 19-20 sets forth features and limitations not recited by the combination of Eilert and Przybylski. Thus, the Applicants respectfully assert that for the above reasons claims 2, 5-11, 13, 16-17, and 19-20 are patentable over the 35 U.S.C. § 103(a) rejection of record.

### **Conclusion**

The Examiner is thanked for the indication that claims 3-4 and 14-15 include allowable subject matter.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Application No.: 09/493,753

Docket No.: 10992091-1

Applicant believes no fee is due with this response. However, if a fee is due, please charge Deposit Account No. 08-2025, under Order No. 10992091-1 from which the undersigned is authorized to draw.

Dated: December 27, 2004

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV482745260US, in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: December 27, 2004

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